

REMARKS

This is in response to the Office Action of April 16, 2010. Applicants gratefully acknowledge the Examiner's indication that this application claims allowable subject matter. Claims 1, 2, 6-8, 12, 15, and 16 are currently pending in this application. Grammatical amendments are made to claims 1, 6, and 16. These are non-narrowing amendments. No new matter has been added by way of the present Amendment. Favorable action on the merits of all of claims 1, 2, 6-8, 12, 15, and 16 is earnestly solicited.

Corresponding foreign applications

Applicants recognize that the outcome of patent application prosecution in foreign jurisdictions is not directly relevant to patent practice in the United States. Nevertheless, it is respectfully pointed out that applications corresponding to the present U.S. application were filed in Japan, Europe, Australia, China, Korea, and Singapore, and that all of those applications have already matured into patents.

The prior art rejections

Claims 1, 6, 7, and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 130 038 (hereinafter "Momoda"). Office Action, pages 2-4. Claims 2 and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Momoda in view of US 5,556,931 (hereinafter "Imura"). Office Action, pages 4-5. Claim 12 was rejected under 35 U.S.C. 103(a) as being unpatentable over Momoda in view of US 3,713,869 (hereinafter "Geffcken"). Office Action, pages 5-6. The rejections are respectfully traversed.

Applicants' position with respect to the rejections of record is set forth in previous responses filed in this application, including in the Amendment filed March 18, 2010. On pages 7-8 of the outstanding Office Action, the Examiner addresses certain of Applicants' arguments in support of the patentability of the present claims. Applicants respond as follows:

Applicants' claim 1 recites "A photochromic lens substrate, which comprises a cured product of a polymerization curable composition ... wherein ... said cured product has a tensile strength of 20 Kgf or more." In item 37., the Examiner contends that "One of ordinary skill

would recognize the necessity of creating a lens that can withstand a baseline amount of abuse.” Even if that contention by the Examiner is accepted as being accurate, it remains that Momoda does not suggest what a lens that can withstand a baseline amount of abuse would be. Therefore, Momoda does not teach that a lens having a tensile strength greater than 20 Kgf, as recited in Applicants’ claims, would be a lens that can stand a baseline amount of abuse.

In items 37. and 38., the Examiner alleges that “one could reasonably experiment with the conditions of the invention to arrive at a tensile strength greater than 20kgf.” However, since Momoda fails to disclose that a lens which can withstand a baseline amount of abuse is a lens having a certain value of tensile strength, persons of ordinary skill in the art would not have been motivated to obtain the lens having a tensile strength greater than 20 Kgf provided by the present invention.

The Examiner implies in item 10. on page 3 of the Office Action that tensile strength can easily be controlled by changing the hardness of a lens. However, as shown in the Rule 132 Declaration filed herein on February 20, 2009, there is no relationship between hardness and tensile strength. Specifically, the Table below (reproduced from the Declaration) shows the hardness (HL hardness) values of photochromic products of Momoda as well as the tensile strength values calculated therefor.

Ex. No.	1	2	3	4	5	6	7	10	11	12	13	14	15	16	17	18	19
Tensile Strength (kgf)	16	10	6	14	11	8	5	10	16	11	15	9	13	10	8	7	10
HL hardness	88	96	100	94	86	93	100	96	95	95	90	93	96	96	100	88	92

Ex. No.	23	24	25	27	28	32	34	35	36	37	45	47	50	57
Tensile Strength (kgf)	12	12	12	15	10	15	17	13	10	11	11	10	10	14
HL Hardness	100	88	84	93	90	89	86	90	96	96	90	96	82	96

As evidenced by the results set forth in the Table, there is no relationship between the tensile strength of a product and its HL hardness. Incidentally, none of the Momoda products has a tensile strength as high as 20 Kgf. Momoda merely discloses cured products having high

hardness and low tensile strengths. Momoda does not in any way teach or suggest a lens substrate comprising a cured product as claimed herein. That is, the Momoda disclosure cannot be viewed as providing any guidance as to how much the hardness of a lens should be changed in order to obtain a tensile strength greater than 20 Kgf.

In the present invention, a lens showing excellent photochromic properties and having a tensile strength greater than 20 Kgf is provided by the precise composition specified in claim 1. Nothing in the Momoda disclosure enables Applicants' invention as a whole. It is respectfully submitted that the rejection of record depends upon impermissible hindsight, at least with respect to its treatment of the quantitative tensile strength feature of Applicants' invention. Withdrawal of the rejection of record is in order and is earnestly solicited.

Conclusion

Should there be any outstanding issues to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher, Registration 28,781, at (703) 205-8008.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

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